

REMARKS

Reconsideration and allowance of the present application is respectfully requested in view of the foregoing amendments and following remarks.

Claims 1-22 are pending, of which claims 1 and 17 are independent. Claims 1-9, 11-15, and 17-21 are amended for clarity, to conform to U.S. patent practice, to assure open-ended coverage, and to enable the apparatus claims to be infringed at the time the goods are sold, prior to being used. Added claim 22 is directed to a processor arrangement for performing the method of claim 1.

Applicant traverses the rejection of claims 1-5 and 7-20 under 35 U.S.C. 102(e) as being anticipated by Porter (U.S. 6,434,599).

Amended independent claim 1 is directed to a method of establishing communication over a data network between endpoint systems using a service system that can set up a communication session with an associated transport mechanism enabling the exchange of data between endpoint systems joined to the session by the service system. The method includes a combination of steps, including processing a communication request received at the service system on the basis of information associated with the request. Processing is effected by (1) identifying an appropriate session for the communication requested from a pool of current

communication sessions and, where no appropriate session currently exists, creating a new appropriate session, and (2) identifying, from a pool of available parties, a specific party and associated endpoint system to join the session identified or created in step (a).

Amended independent claim 17 is directed to a service system having a combination of features, including a session entity for establishing communication sessions and controlling the joining of endpoint entities to each communication session; a transport entity for establishing a transport mechanism for each session established by the session entity, the transport mechanism being arranged for allowing the exchange of data across a network between endpoint entities joined to the session; and request-handling means for receiving and processing a communication request to join a requesting endpoint entity into an appropriate session with another endpoint entity on the basis of information associated with the request. The request-handling means includes session-routing means for identifying, from a pool of current communication sessions, an appropriate session for the communication requested and, where no appropriate session currently exists, creating a new appropriate session, and participant-routing means for identifying, from a pool of available parties, a specific party and associated endpoint

system to join the session identified or created by the session-routing means.

A rejection based on 35 U.S.C. §102 requires that every element of the claim be included in the reference, either directly or inherently. Porter does not disclose all elements of Applicant's independent claims 1 and 17 as required by 35 U.S.C. §102.

First, contrary to the assertion in the Office Action, Porter does not identify an appropriate session for the communication requested from a pool of current communication sessions and, where no appropriate session currently exists, create a new session. Porter merely describes a system which polls users to ascertain whether any of the users wish to participate in a chat session with a requesting user. See column 4, line 55, through column 5, line 22. Porter offers a system for finding out which users desire to chat with the requesting user. Porter does not identify an appropriate session for the communication requested, but is simply concerned with enabling a visitor to a site to chat with others, subject to the consent of the others, regarding subjects of mutual interest.

In Porter, the polled users identify whether they wish to chat with the requesting user. The Porter system does not identify an

appropriate session as in the presently claimed invention. According to Porter, "if at least some of the consenting users are already participating in an earlier dynamically formed chat session, the initiating user as well as the 'non-participating' consenting users are added to an appropriate one of the earlier formed chat sessions." See column 5, lines 1-5. In other words, Porter adds the consenting users and the requesting user to a session without identifying an appropriate session or creating a new session for the communication requested. In contrast to Porter and in accordance with Applicant's claimed invention, an appropriate session is identified based on the communication requested by the requesting user.

Second, Porter, at most, carries out only a single selective identification process, that is, identifying to which session a requesting user is to be joined in the case of participants from more than one session consenting to chat with the requesting user. Porter states, "In alternate embodiments, a tiebreaking scheme, e.g. by weight and so forth, may be employed to automatically decide which earlier formed chat session is the appropriate chat session if chat participants of more than one chat session gave their consents." See column 5, lines 8-13. As noted, if the consenting parties agree to chat with the requesting user, the

Porter system may decide to which session the requesting user and consenting parties may be joined without first determining an appropriate session for the communication requested. Porter also fails to identify a specific party and associated endpoint system to join to the session.

In contrast, Applicant's independent claims 1 and 17 have two selective identification steps/features: (1) session selection/identification for the communication requested, and (2) party selection/identification. Porter fails to disclose these selective identification steps and features. Thus, Porter fails to anticipate the subject matter of independent claims 1 and 17 as originally filed and as currently amended.

For one or both of the foregoing reasons, withdrawal of the rejection of claims 1 and 17 based on Porter is in order.

Claims 2-5, 7-16, and 18-20 depend directly or indirectly from independent claims 1 and 17 and are patentable over Porter for at least the same reasons, as well as for the additional limitations provided. For example, Porter fails to disclose a service session functional entity as required by dependent claims 7 and 9. Therefore, for at least the foregoing reasons, withdrawal of the rejection of claims 2-5, 7-16, and 18-20 is in order.

Applicant traverses the rejection of claims 6 and 21 under 35 U.S.C. 103(a) as being unpatentable over Porter in view of Cave (U.S. 5,958,014).

Claims 6 and 21 depend respectively from allowable independent claims 1 and 17 and are allowable for at least the same reasons, since Cave fails to cure the deficiencies of Porter as a primary reference. Withdrawal of the rejection of claims 6 and 21 based on Porter and Cave is, therefore, in order.

Further, the Office Action fails to identify any teaching, suggestion, or motivation to combine Porter with Cave. According to the Office Action, it would have been obvious to one of ordinary skill in the art at the time of the present invention to combine Porter with Cave in order to "connect the user to the next available agent for bi-directional data exchange." This assertion notwithstanding, the Office Action does not point out any satisfactory motivation or suggestion in either reference to support the asserted combination. The Office Action appears to improperly apply hindsight reasoning based on the present invention to make the asserted combination. The rationale that the references are from a similar area ("in an analogous art") does not explain why the combination would have been obvious to a person of

ordinary skill in the art or why such a person would have been motivated to combine the references.

Merely stating that combining prior art references to meet a claimed invention would have been well within the ordinary skill of the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references. See MPEP 2143.01 quoting *Ex parte Levengood*, 28 USPQ2d 1300 (BPAI 1993). The Office Action does not state any desired result that flows from the combination. Accordingly, the Office Action fails to supply sufficient objective reasons to combine Porter and Cave.

The Office Action does not identify any teaching in Porter or Cave motivating a person of ordinary skill in the art to make, or suggesting, the asserted combination, nor does the Office Action provide an affidavit, perhaps because there is no teaching to be found. For at least this reason, the rejection of claims 6 and 21 based on Porter and Cave should be withdrawn. However, if the rejection is maintained, the Examiner is respectfully requested, in accordance with MPEP §2143.01 and *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999), to identify a teaching, suggestion, or motivation in either reference or to provide an affidavit of facts within the Examiner's personal

knowledge per MPEP §2144.03 providing motivation or a suggestion to one of ordinary skill in the art to make the proposed combination.

"When an obviousness determination is based on multiple prior art references, there must be a showing of some 'teaching, suggestion, or reason' to combine the references." *Winner International Royalty Corp. v. Wang*, 53 USPQ2d 1580, 1586 (Fed. Cir. 2000). The Office Action fails to make such a showing for supporting the applied combination of references; therefore, the applied combination of references is improper. For this additional reason, the rejection of claims 6 and 21 should be withdrawn.

All objections and rejections having been addressed, it is respectfully submitted that the present application is in condition for allowance, and a Notice to that effect is earnestly solicited.

To the extent necessary during prosecution, Applicant hereby requests any required extension of time not otherwise requested and hereby authorizes the Commissioner to charge any prescribed fees not otherwise provided for, including application processing,


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extension of time, and extra claims fees, to Deposit Account No.
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Respectfully submitted,

Lawrence WILCOCK

By:


Randy A. Noranbrock
Reg. No. 42,940

HEWLETT-PACKARD COMPANY

Intellectual Property Administration
P. O. Box 272400
Fort Collins, CO 80527-2400
703-684-1111 telephone
970-898-0640 telecopier
AML:RAN:rk